

Appl. No. 10/674,923
Amdt. dated October 26, 2004
Reply to Office action of July 30, 2004

REMARKS/ARGUMENTS

Receipt of the Office action dated July 30, 2004 is hereby acknowledged. In that Action the Examiner: 1) rejected claims 10, 20, 26, 28 and 29 as allegedly invalid under Section 112, first paragraph; 2) rejected claims 10, 20, 26, 28 and 29 as allegedly indefinite; 3) rejected claims 1 and 24-27 for alleged obviousness-type double patenting; 4) rejected claims 24-25 as allegedly unpatentable over Bard (U.S. Pat. No. 6,530,026); 5) rejected claims 1 and 27 as allegedly obvious over Bard taken with Cho (U.S. Pat. No. 6,119,237).

With this Response, Applicants amend claims 25 and 26, cancel claim 24, and present new claims 30-33. Reconsideration is respectfully requested.

I. SECTION 112, FIRST PARAGRAPH REJECTIONS

The Office action dated July 30, 2004 rejects claims 10, 20, 26, 28 and 29 under Section 112, first paragraph, stating, "The modification of USB Interfaces critical or essential to the practice the invention, but not included in the claim(s), is not enabled by the disclosure. ... By claiming powering of the laptop by a device over USB power lines, the invention is not enabled because it is not within the scope of the USB specification to do so." Applicants respectfully traverse the assertion of the Office action that claiming a departure from a previous standard results in non-enablement.

The Manual for Patent Examining Procedures (MPEP) defines the test for enablement under Section 112 as follows:

[W]hether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. ... [E]ven though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation.

(MPEP 2164.01).

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Applicants' specification provides a docking logic 134 in the laptop that, in some modes, operates under an illustrative USB protocol.

Under standard USB protocol, the laptop computer 100 provides power to USB devices downstream of the laptop computer 100. **Thus, in normal operation, the USB protocol voltage control unit 140 receives a five volt input signal 142 which it couples to the positive power rail 144 of the power conductors 138.** Downstream USB devices may draw current through the positive power rail 144. If a user of the laptop computer 100 plugs in, for example, a USB mouse into the USB connector 136, that mouse under USB protocol may draw power across the power conductors 138 for its operational use.

(Specification Figure 2; page 8, line 19 – page 9, line 2 (emphasis added)). In other modes, however, the laptop turns off the power provided on the power rails, and instead receives power on those power rails, such as from a docking station. (Specification Page 9, line 19 – page 10, line 6). In order to accomplish this role reversal for the illustrative USB power lines, the specification describes hardware (both in the laptop and the docking station and including part numbers) and related methods to test for compatibility of the laptop to receive power prior to assertion of power. (Specification page 8, line 15 – page 12, line 13; page 11, line 5 – page 12, line 2).

While in some modes the various embodiments may part with the illustrative USB protocol, the hardware and methods used to depart from the standard are enabled. Thus, Applicants respectfully submit one skilled in the pertinent art could make and use the claimed invention in spite of the departure from the illustrative USB protocol, and thus the mere fact of the departure from the illustrative USB protocol in some modes of operation does not render the claims invalid.

II. SECTION 112, SECOND PARAGRAPH REJECTIONS

The Office action dated July 30, 2004 rejected claims 10, 20, 26, 28 and 29 under Section 112, second paragraph, alleging indefiniteness. As best understood, the rejection seems to imply that because power flow is claimed in

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some modes opposite of that defined in the USB specification, that the claims are allegedly indefinite. Applicants respectfully traverse this rejection.

The specification clearly discloses a dual purpose interface that, in some modes may operate, e.g., as an USB interface (Specification Figure 2; page 8, line 19 – page 9, line 2), and in other modes departs with the illustrative USB specification and accepts power to power the laptop (Specification Page 9, line 19–page 10, line 6). Applicants respectfully submit that claiming additional functionality of an illustrative USB interface does not render the claims indefinite.

III. DOUBLE PATENTING

In order not to hinder further prosecution of this matter, but without acknowledging the propriety of the double-patenting rejection of the Office action, Applicants submit concurrently herewith a terminal disclaimer over U.S. Patent number 6,668,296, thus negating the obviousness-type double patenting rejections.

IV. ART-BASED CLAIM REJECTIONS

A. Claim 1

Claim 1 stands rejected as allegedly obvious over Bard in view of Cho.

Bard appears to be directed to a circuit and method for power distribution management. (Bard Title). Referring to Bard's Figures 1 or 3, it appears that control signals for control of the power distribution are separate and apart from the power lines Vp and Vg. (See Bard Col. 3, line 26 – Col. 5, line 64 (discussing power flow in relation to states of the various control signals)). Cho appears to be directed to regulating power supplied from a docking station to a portable computer. (Cho Title). In particular, Cho appears to verify whether a secure electrical connection has been made between the portable computer and the docking station, and whether the portable computer has a secure mechanical lock, before supplying power. (Cho Abstract).

Claim 1, by contrast, specifically recites, "wherein the device determines if the laptop computer is capable of being powered across the power lines of the communication bus **by communication with the laptop across the power lines of said communication bus.**" Bard and Cho do not teach or fairly suggest a

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determination of whether a laptop is capable of being powered across power lines of a communication bus, or that such a determination should be made by communication across the power lines of the communication bus.

Based on the forgoing, Applicants respectfully submit that claim 1, and all claims which depend from claim 1 (claims 28 and 29), should be allowed.

V. NEW CLAIMS

With this Response, Applicants present new claims 30-33. Applicants respectfully submit that new claims 30-33 are not taught or rendered obvious by the cited art.

VI. CLAIM CANCELLATIONS

With this Response, Applicants cancel claim 24 without prejudice to later asserting this claim, such as in a continuation application. Because of the cancellation of claim 24, Applicants re-write claim 26 into independent form, and amend claim 25 to depend from claim 26 rather than claim 24.

VII. CONCLUSION

Applicants respectfully request reconsideration and allowance of the pending claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

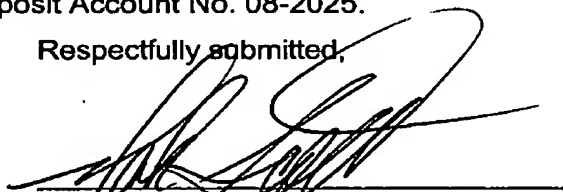
In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of

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time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



Mark E. Scott
PTO Reg. No. 43,100
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400